

Atty. Docket No.: 387953

PATENT

IN THE UNITED STATES PATENT OFFICE

Patent Application Serial No. 09/578,631

Group No.: 3627

Filed: May 25, 2000

Examiner: F. Bartuska

Title: DISK DISPENSING AND RETRIEVAL
SYSTEM AND ASSOCIATED METHODS

Confirmation No.: 5757

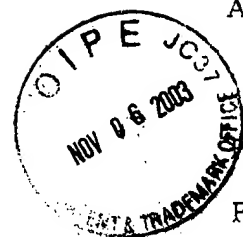
Inventors: William H. Barber and Philip J. Tomasi

**DECLARATION OF WILLIAM H. BARBER
IN ACCORDANCE WITH 37 CFR §1.131**

I, William H. Barber, hereby declare:

1. I am a named inventor in U.S. Patent Application No. 09/578,631 (the '631 Application), filed on May 25, 2000.
2. I currently reside at 1845 Brush Oak Court, Thousand Oaks, CA 91320; I have obtained the following university degrees: B.A. (UCSB, 1987), M.B.A. (CU, 1998)
3. I am a founder and Director of DVDPlay, Inc. (formerly Freeflyr, Inc.), which owns all right, title and interest in and to the '631 Application.
4. I have studied and understood the specification and claims in the '631 Application. The claims of the '631 Application generally relate to a disk dispensing and retrieval system, and methods thereof, such as to dispense DVDs to users.
5. I have read and understood the contents of the Office Action dated August 6, 2003 for the '631 Application.
4. I have read and understood the references cited by the Examiner in the Office Action of August 6, 2003, in particular, United States Patent No. 5,934,439, issued August 10, 1999, to Kanoh et al. and United States Patent No. 6,289,322, issued September 11, 2001 to Kitchen et al.
5. This Declaration is being presented under 37 C.F.R. §1.131 to show prior invention by virtue of conception prior to the effective filing dates of Kanoh et al. (September 2, 1997) and Kitchen et al. (March 3, 1998) and continued due diligence from conception to an effective reduction to practice in the effective filing date of the '631 Application.
6. Attached hereto are Exhibits 1-22. Exhibit 1 is a copy of preliminary business feasibility notes from my executive Masters of Business Administration ("MBA") business retreat. Exhibit 2 is a copy of my University of Colorado MBA transcripts. Exhibit 3 is a Declaration of Scott Mackey. Exhibits 4-21 are copies from my lab notebook ("Lab Notebook") stored in a safe deposit box at Wells Fargo Bank, 140 E. Thousand Oaks Blvd, Thousand Oaks, CA 91360.

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Atty. Docket No.: 387953

7. In June of 1997, I attended an executive Masters of Business Administration ("MBA") business retreat hosted by the University of Colorado, where I participated in a business feasibility exercise. Exhibit 1 is a copy of the notes from this exercise, laying out the concept for the disk dispensing and retrieval system later described in a patent application filed on May 25, 1999 as U.S. Application Serial No. 60/135,854 (the '854 Application).

8. From June of 1997 through June of 1998, I continued full time enrollment in the MBA program offered through the Graduate School of Business Administration, University of Colorado, Denver (transcripts attached as Exhibit 2). Throughout this time period, in tandem with courses at the University of Colorado, I developed a business model to launch a company to commercialize the disk dispensing and retrieval system later filed in the '854 application. In particular, several business plans and Excel charts were developed during this time period to validate the business model (see Exhibit 3).

9. Exhibit 4 is one page of the Lab Notebook dated June 17, 1998 and describing (a) a design for a disk dispensing and retrieval system and (b) a plan for prototyping the disk dispensing and retrieval system in 1998.

10. Exhibit 5 is one page of the Lab Notebook dated June 22, 1998 and describing meetings with lawyers at the law firms of Chrisman, Bynum & Johnson and Cooley Godward; these meetings included discussions regarding the patenting of the disk dispensing and retrieval system.

11. Exhibit 6 consists of two pages of the Lab Notebook dated June 23, 1998 and illustrating possible disk configurations for the disk dispensing and retrieval system.

12. Exhibit 7 is one page of the Lab Notebook dated June 26, 1998 and describing a telephone call with Cooley Godward and further development of the disk dispensing and retrieval system with Philip Tomasi, another named inventor of the '631 application.

13. Exhibit 8 is one page of the Lab Notebook dated June 30, 1998 and describing (a) market research for the disk dispensing and retrieval system and (b) a meeting with North Communications, which was considered a possible commercialization partner.

14. Exhibit 9 consists of three pages of the Lab Notebook, dated July 2, 1998 through July 7, 1998, and describing (a) market research regarding Blockbuster video rentals, (b) further kiosk design illustrations, and (c) a confidential meeting with K.I.S. regarding engineering design for the disk dispensing and retrieval system.

15. Exhibit 10 is one page of the Lab Notebook dated July 31, 1998 and describing a conference call with Philip Tomasi and North Communication, regarding kiosk design particulars.

16. Exhibit 11 is one page of the Lab Notebook dated August 5, 1998 and describing a meeting with Gary Bloomer of the Boulder Technology Incubator, to assist in commercialization

Atty. Docket No.: 387953

of the disk dispensing and retrieval system.

17. Exhibit 12 is one page of the Lab Notebook dated August 20, 1998 and describing a patent search and contact with CD equipment manufacturers.
18. Exhibit 13 consists of two pages of the Lab Notebook dated August 31, 1998 and describing a meeting with Philip Tomasi regarding a development plan for the disk dispensing and retrieval system; Exhibit 10 further describes purchase and installation of a DVD-ROM drive and touch screen prototype.
19. Exhibit 14 consists of two pages of the Lab Notebook dated September 27, 1998 and October 13, 1998, respectively, which describe testing of CD and DVD transport systems.
20. Exhibit 15 is one page of the Lab Notebook dated October 30, 1998 and describing signing a lease with Boulder Technology Incubator, to assist in commercializing the disk dispensing and retrieval system.
21. Exhibit 16 is one page of the Lab Notebook dated November 2, 1998 and describing further development of the disk dispensing and retrieval system during a first residence day at the Boulder Technology Incubator.
22. Exhibit 17 is one page of the Lab Notebook dated November 5, 1998 and describing a meeting with the Chrisman, Bynum and Johnson law firm regarding forming a business entity to commercialize the disk dispensing and retrieval system.
23. Exhibit 18 consists of three pages of the Lab Notebook dated November 19, 1998, November 20, 1998, and November 23, 1998, respectively, and describing design particulars for the disk dispensing and retrieval system.
24. Exhibit 19 consists of two pages of the Lab Notebook dated December 7, 1998 and December 8, 1998, respectively, and describing meetings with potential lawyers and advisory board members to assist in commercializing the disk dispensing and retrieval system.
25. Exhibit 20 is one page of the Lab Notebook dated December 16, 1998 and describing further design issues for the disk dispensing and retrieval system.
26. Exhibit 21 consists of two pages of the Lab Notebook dated January 5, 1999 and January 6, 1999 (these pages incorrectly recite 1998), respectively, and describing further DVD kiosk development and meetings with lawyers to discuss forming an LLC to commercialize the disk dispensing and retrieval system; this LLC was formed January 15, 1999 as Freeflyr, LLC, which merged into Freeflyr, Inc. August 16, 2000.
27. Exhibit 22 is one page of the Lab Notebook setting forth press release collateral of the disk dispensing and retrieval system for use in public meetings after May 25, 1999; the press release was prepared during a period of January 1, 1999 and May 25, 1999.

Best Available Copy

Atty. Docket No.: 387953

28. From May of 1999 to July of 1999, materials for filing of a patent application for the disk dispensing and retrieval system were prepared; that patent application was filed on July 13, 1999 as U.S. Application Serial No. 60/143,601 (the '601 Application) and included mechanical drawings for DVD transfer mechanisms and source code.

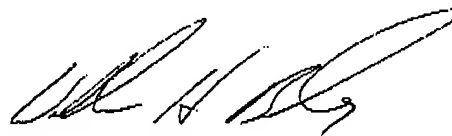
29. I conceived and, with due diligence, pursued a constructive reduction to practice of the disk dispensing and retrieval system entirely within the United States.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the Application or any patent issued thereon.

Respectfully submitted,

Dated

11/5/2003



William H. Barber

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